THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte UDO BECKER, KONRAD BRAUN and NORBERT HEIMBURGER

Appeal No. 95-1293
Application 07/727,387[1]

ON BRIEF

Before WINTERS, GRON and TORCZON, Administrative Patent Judges
WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 11, 12, 13, 15 and 16, which are all of the claims remaining in the application.

[1]Application for patent filed July 5, 1991. According to appellants, this application is a continuation of application 07/240,649, filed September 6, 1988, now abandoned.

Claim 15, which is illustrative of the subject matter on appeal, reads as follows:

> 15. A method for the determination of soluble fibrin in a body fluid, comprising the steps of:
>
> a) binding fibrinogen to a solid phase support;
>
> b) incubating a sample of said body fluid with the solid phase bound fibrinogen whereby the soluble fibrin specifically binds to the solid phase bound fibrinogen, immobilizing the soluble fibrin;
>
> c) separating said immobilized soluble fibrin from said body fluid;
>
> d) providing an antibody able to react immunochemically with the immobilized soluble fibrin, said antibody being covalently linked to a detectable label to form a labeled antibody capable of immunochemically reacting with the immobilized soluble fibrin;
>
> e) contacting the labeled antibody with the solid phase bound fibrinogen which has been pre-incubated with said body fluid to specifically bind the label to said immobilized soluble fibrin;
>
> f) detecting said bound label; and
>
> g) <u>determining the concentration of soluble fibrin in the body fluid</u> from said bound label wherein said antibody covalently linked to said detectable label is derived from an animal of the same species from which the fibrinogen is obtained but which is not the same species as

> the animal from which the body fluid is taken. [emphasis added]

The references relied on by the examiner are:

Tom et al. (Tom) 4,366,241 Dec. 28, 1982

Chem. Abst., Vol. 104, No. 3, 17365m, January 20, 1986, of Scheefers-Borchel, et al., "Determination of fibrin with fibrin-specific antibodies", Eur. Pat. Appl. EP 152,612, published August 28, 1985. (Scheefers-Borchel)

Stemberger, et al., "Determination of Soluble Fibrin Monomer Complexes by Adsorption on Immobilized Fibrinogen", Thrombos. Haemostas. (Stuttg.), Vol. 39, pp. 574-581 (1978). (Stemberger)

Respecting Scheefers-Borchel, the examiner does not rely on European Patent Application 152,612 in its entirety. Rather, the examiner makes clear that she relies on the abstract of the European Patent Application (Examiner's Answer, Paper No. 21, pages 2 and 3). Appellants also refer to the abstract in their appeal brief, Paper No. 19, page 2. Likewise, we have limited our review to the above-cited published abstract, not European Patent Application 152,612.

The previously entered rejection of claims 11, 12, 13, 15 and 16 under 35 USC § 103 as unpatentable over Scheefers-Borchel in view of Stemberger and, "if necessary", further in

view of Lenz, et al. (U.S. Patent No. 4,914,040) and Tom, has been with-drawn. See the Supplemental Answer, Paper No. 23, paragraph bridging pages 2 and 3. The issue remaining for review is whether the examiner erred in rejecting claims 11, 12, 13, 15 and

16 under 35 USC § 103 as unpatentable over Scheefers-Borchel in view of Stemberger "and, if necessary, further in view of" Tom.

Discussion

On consideration of the record, including appellants' main brief (Paper No. 19), the reply brief (Paper No. 22), the Examiner's Answer (Paper No. 21), and the Supplemental Answer (Paper No. 23), we reverse the rejection under 35 USC § 103.

Appellants argue that when all of the prior art is considered together, one of ordinary skill would not have a sufficient basis for the requisite reasonable expectation of success to sustain a rejection under 35 USC § 103. See In re Clinton 527 F.2d, 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

According to appellants, even if the references were combined in the manner proposed by the examiner,

> there is no disclosure in the prior art of the nature of the fibrin/fibrinogen binding. Thus, there is nothing in the references to suggest that the specific binding between fibrin and fibrinogen in Stemberger is the same as the type of binding between antibodies and antigens described in Scheefers-Borchel. The latter binding (antibody/fibrin) is an immunological reaction whereas the former binding (fibrin/fibrinogen) may be, e.g., intramolecular hydrogen binding. Fibrinogen simply cannot be equated to an antibody directed against fibrin. [appeal brief, Paper No. 19, page 10]

We generally agree with this line of reasoning.

On this record, the examiner has not established that Stemberger's adsorption of plasma fibrin on fibrinogen-Sepharose has the same strength and selectivity compared with the antigen/antibody binding described by Scheefers-Borchel. Therefore, even if the prior art references were combined in the manner proposed, a person having ordinary skill would not have arrived at the claimed method with a reasonable expectation of success. Note that independent claims 15 and 16 define a quantitative method for determining soluble fibrin in a body fluid. Step(g) in each claim requires "determining

the concentration of soluble fibrin in the body fluid". Where, as here, the examiner has not established that persons having ordinary skill in the art would have expected that the adsorption binding of Stemberger has the same strength and selectivity as the antigen/antibody binding of Scheefers-Borchel, we find that the references would not have led persons having ordinary skill in the art to appellants' method for quantitatively determining soluble fibrin in a body fluid with a reasonable expectation of success.

At most, a person having ordinary skill would have found it obvious to try the proposed modification of the Scheefers-Borchel, per the teachings of Stemberger and "if necessary", Tom.

Obvious to try, however, is an improper consideration in adjudicating obviousness. Hybritech Inc. v. Monoclonal Antibodies, Inc. 802 F.2d 1367, 1380, 231 USPQ 81, 91 (Fed. Cir. 1986).

The examiner's decision is reversed.

Reversed

SHERMAN D. WINTERS Administrative Patent Judge	)	
TEDDY S. GRON Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
RICHARD TORCZON Administrative Patent Judge	)	

vsh

Finnegan, Henderson, Farabow,
Garrett & Dunner
1300 I Street, NW
Washington, DC 20005-3315